



Attorney Docket No. 086142-0533

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yoshiyuki NAKANO *et al.*

Title: PRETENSIONER

Appl. No.: 10/064,720

Filing Date: 08/09/2002

Examiner: George D. Spisich

Art Unit: 3616

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New Pre-Appeal Brief Conference Pilot Program, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal in response to the Final Office Action that was mailed on December 15, 2005.

Remarks begin on page 2 of this document.

REMARKS

The Final Office Action that was mailed on December 15, 2005 has been reviewed and the Examiner's comments have been carefully considered. Of claims 1-16 that were pending, claims 1-4 and 7-16 stand rejected and claims 5 and 6 are allowed. Accordingly, of claims 1-16 that remain pending, claims 1-4 and 7-16 are submitted for reconsideration.

Claims 1-4 and 7-16 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious when considering DE 42 27 780 ("Prinz") in view of U.S. Patent No. 5,908,222 ("Wier"). Applicants respectfully traverse this rejection because the references fail to disclose, teach or suggest the claimed invention.

The Examiner again contends that it would have been obvious to one of ordinary skill to replace Prinz's cylinder 20 with Wier's tube 10 and to replace Prinz's piston 22 with Wier's piston 12, "to provide a sturdy, efficient and effective pretensioner with locking ability." Office Action at p. 4. The Examiner, however, failed to address Applicants' arguments regarding the failure of both Prinz and Wier to provide any support for the Examiner's assertion that one of ordinary skill in the art would have been motivated to modify Prinz' pretensioner to include a constant diameter linear portion "to provide a sturdy, efficient and effective pretensioner with locking ability." Neither Prinz nor Wier teaches, discloses, or suggests that the structure of Prinz is deficient in some capacity.

In addition to the foregoing, Applicants previously argued that whereas Prinz does not teach, disclose, or suggest any shape of the cylinder 20 other than linear, Wier teaches, in the embodiments of Figures 1A and 1B, that the piston 12 initially travels through a curved portion of the tube 10. *See* col. 2, lines 40-43. As a result, replacing Prinz's cylinder 20 with Wier's tube 10 would entail moving the piston through a curved portion. In contrast, claims 1 and 10 recite that the piston is "configured to move only within the linear portion."

In the "Response to Arguments" section of the Office Action, the Examiner countered this argument by citing to col. 2, lines 45-46 of Wier, which teaches that a lower section of the tube 10 may be "uncurved." Applicants respectfully note, however, that the same portion of Wier teaches an upper section of the tube may be "curved." Regardless, the Examiner can not pick-and-choose a particular teaching of a reference and disregard the reference's other teachings. Rather, the Examiner must consider a reference in its entirety. *See, e.g., In re Wesslau*, 353 F.2d 238, at 241, 147 U.S.P.Q. 391 (C.C.P.A. 1965); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, at 448, 230 U.S.P.Q. 416 (Fed. Cir. 1986).

Contrary to this established legal principle, the Examiner stated (on pages 4-5 of the Office Action) that he "is not relying on the entire tube of Wier" and instead is only applying the end portion of Wier's tube "to modify the tapered end portion of the linear tube of" Prinz. However, there is no motivation to modify the tapered end portion of Prinz. The tapered end of the tube 20 disclosed in Prinz performs a stopping function to limit the movement of the piston 22 and, therefore, it would not be obvious to modify this feature. In contrast, the instant invention employs a simple, non-tapered tube. Accordingly, even if one of ordinary skill in the art were motivated to combine Prinz and Wier, the resulting structure would not read on the invention recited in claims 1 and 10.

For at least the aforementioned reasons, the combination of Prinz and Wier fails to disclose, teach, or suggest each of the limitations of independent claims 1 and 10. Accordingly, the rejection of claims 1 and 10 should be withdrawn. Moreover, as claims 2-4, 7-9, and 11-16 depend from either claim 1 or claim 10, each of these dependent claims is also allowable over the combination of Prinz and Wier, without regard to the further patentable limitations contained therein. Accordingly, a withdrawal of the rejections of claims 1-4 and 7-16 is both warranted and earnestly solicited.

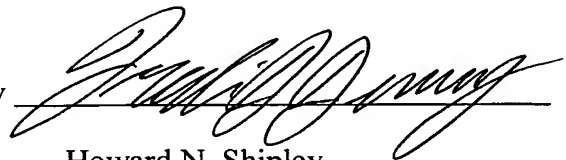
CONCLUSION

For the aforementioned reasons, claims 1-16 are in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

Date March 30, 2006

By



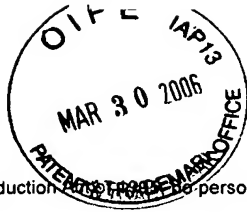
Howard N. Shipley
Registration No. 39,370

Frederic T. Tenney
Registration No. 47,131

Attorneys for Applicants

Customer Number: 22428
FOLEY & LARDNER LLP
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HERewith, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HERewith, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.



Under the Paperwork Reduction Project 1994-1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

086142-0533

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On

Signature

Typed or printed name

Application Number

10/064.720

Filed

August 9, 2002

First Named Inventor

Yoshiyuki NAKANO

Art Unit

3616

Examiner

George D. Spisich

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number

47,131

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34


Signature

Frederic T. Tenney

Typed or Printed Name

(202) 672-5300

Telephone Number

March 30, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.